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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

BIRD, J

ART UNIT

PAPER NUMBER

3762

DATE MAILED: 02/05/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/649,293

Applicant(s)

COHEN, LAWRENCE T.

Examiner

John M. Bird

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-9 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

1. Claim 5 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend on any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim 5 has not been further treated on the merits.

### *Claim Rejections - 35 USC § 112*

2. Claims 1, 3, 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the transitional phrase "having" can be interpreted as either an open or a closed transitional phrase (it is suggested to use either --comprising-- or --consisting of--).

In claims 1 and 6, "the cochlea" lacks antecedent basis (it is suggested to use "a cochlea").

In claims 3 and 8, "one region" and specific "regions" are inferentially included and not positively recited as elements of the electrode array (it is suggested to positively recite that the electrode array includes regions before referring to these regions).

In claim 6, "the electrodes" lacks antecedent basis (it is suggested to use positively recite electrodes as elements of the electrode array before referring to the electrodes).

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hochmair et al. (4,284,856). With respect to claims 1 and 6, Hochmair discloses a multi-electrode cochlear implant and method of making the implant in which the positions of the electrodes are selected so that the device stimulates different regions of the cochlea for a desired frequency response (column 5, line 47- column 6, line 4). The elements of the claims are met by the reference.

With respect to claims 2 and 7, because the frequency regions are closer together at the apical end of the electrode than those leading up to the basal end (Fig. 6), it is inherent that in order for the electrodes to be positioned to stimulate these regions, the implantable electrodes must also be closer together at the apical end of the implantable electrode array than at the basal end. Thus, claims 2 and 7 inherently read on the reference.

5. Claims 1, 3/1, 4/1, 6, 8/6, and 9/6 are rejected under 35 U.S.C. 103(b) as being anticipated by Hochmair-Dosoyer et al. ("Eight Channel Scala Tympani Electrode for Auditory Prostheses). Hochmair-Dosoyer discloses an electrode array in which separate electrodes are selectively positioned so that they are closer together in one portion of the array than in another portion and the spacing between three of the electrodes is uniformly graduated (page 46, ¶ 6). The elements of the claims are met by the reference.

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*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 4, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hochmair. Hochmair discloses the claimed invention except for a multi-electrode cochlear implant and method of making the implant in which the spacing between electrodes is either different in different regions of the electrode array or uniformly graduated. Hochmair, however, does teach a multi-electrode cochlear implant and method of making the implant in which the spacing of the electrodes is closer together at the apical end of the electrode than at the basal end of the cochlea in order to provide a selected frequency response as discussed above.

Thus, it would have been an obvious design choice to one of ordinary skill in the art at the time of invention to use a spacing between electrodes that is either different in different regions of the electrode array or uniformly graduated to achieve the benefit of positioning the electrodes closer together at the apical end of the implant than at the basal end in order to provide a selected frequency response as taught by Hochmair, since applicant has not disclosed that the spacing between electrodes that is either different in different regions of the electrode array or uniformly graduated over the length of the electrode array provides any criticality and/or unexpected results over any other spacing pattern in which the electrodes are merely closer together at the apical end of the implant than at the basal end and it appears that the invention would perform equally well with any similar electrode spacing.

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In the alternative, Hochmair provides a clear suggestion that an electrode array in which the electrodes are positioned closer together at the apical end of the implant than at the basal end in order to provide a selected frequency response can be modified so that any specific spacing pattern, such as a spacing in which the electrodes are either spaced differently in different regions of the electrode array or uniformly graduated over the length of the electrode array, can be used. The determination of the most appropriate specific spacing pattern by routine experimentation would, therefore, be prima facie obvious to one having ordinary skill in the cochlear implant art.

*Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Bird whose telephone number is (703) 605-4354. The examiner can normally be reached on Monday - Friday 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela D. Sykes can be reached on (703) 308-5181. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-4520 for regular communications and (703) 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

JB  
January 31, 2001

*George R. Evans*  
Patent Examiner  
1/31/01